

Group II in the Office action of March 15, 2002, it is stated that

... an error in the USPTO form paragraph used in item no. 2 of the last Office action that indicates that MPEP 806.05(c) Section III requires that the combination does not require the particulars of the subcombination for patentability. In fact, ... the standard in evidence claim situations is that an evidence claim is present that indicates the combination is *not relying on* the particulars of the subcombination, even though the claimed combination does clearly require the particulars of the subcombination. See MPEP 806.05(c) Section III.

(page 2 of the June 24 Office Action). **This statement is clearly incorrect.** The form paragraph used in the March 15 Office Action correctly states the rule to apply in determining distinctness for combination/subcombination claim situations. A copy of MPEP 806.05(c) from the eighth edition of the MPEP is attached to the present paper, which shows the form paragraph cited therein is identical to the form paragraph used in the March 15 Office Action. Also attached is a copy of MPEP 806.05(c) from the seventh edition of the MPEP, which further shows that the form paragraph for MPEP 806.05(c) is identical to the form paragraph used in the March 15 Office Action. Applicants are not aware of the existence of any edition of the MPEP that cites a different form paragraph to use for MPEP 806.05(c). Applicants respectfully request the Examiner to provide any and all official documents for patent examining procedures and/or versions of MPEP 806.05(c) which present a

different form paragraph and particularly a different criteria to apply in combination/subcombination situations. In an absence of any such document/MPEP edition that supercedes the clear and plain reading of MPEP 806.05(c) of the eighth edition of the MPEP, the form paragraph listed in MPEP 806.05(c) correctly states the criteria that *must* be applied to support a finding of distinctness in combination/subcombination claim situations.<sup>1</sup>

With regard to specific criteria necessary to establish that combination and subcombination inventions are distinct, MPEP 806.05(c) requires the existence of two elements. Reference is made to MPEP 806.05(c) in the eighth edition of the MPEP in which it is stated:

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See MPEP §§ 808.02.

The inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in other and different relations.

When these factors cannot be shown, such inventions are not distinct.

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<sup>1</sup> See the first paragraph of MPEP 806.05(c), "In order to establish that combination and subcombination inventions are distinct, two-way distinctness *must* be demonstrated." (emphasis added).

This two-element requirement is stated in MPEP 806.05(c) as well as the form paragraph appearing therein. Element (A) requires that the combination as claimed does not require the particulars of the subcombination as claimed for patentability.

In sharp and distinct contrast, it is stated in the June 24 Office Action that, with respect to the criteria for determining distinctness of combination/subcombination inventions, distinctness is shown if an evidence combination claim indicates the combination is not relying upon the particulars of the subcombination, "even though the claimed combination does clearly require the particulars of the subcombination". Applicants cannot find any language in MPEP 806.05(c) or elsewhere in the MPEP that states that the above-described two element criteria is inapplicable, and especially language that allows for distinctness in combination/subcombination situations even if the combination *clearly requires the particulars of the subcombination*.

Even assuming, for the sake of argument, that distinctness may be shown using the criteria identified in the June 24 Office Action (i.e., that distinctness is shown if a combination claim indicates that the combination does not rely upon the specific details of the subcombination for patentability), Applicants respectfully submit that the criteria is misapplied. For instance, Group II combination claim 65 (the claim identified in

both Office Actions) recites a wavelength division device, comprising 1) first coupling components for supporting a plurality of signal carriers, 2) a second coupling component for supporting a signal carrier, and 3) a diffraction grating in optical communication with the signal carriers coupled to the first and second coupling components so as to diffract input optical rays over a wavelength range of at least approximately 30nm in which the wavelength division device is substantially polarization insensitive. Group I subcombination claim 25 recites a diffraction grating having means for diffracting the one or more input optical signals into one or more output optical signals over a wavelength range of at least 30nm, over which the grating is substantially polarization insensitive. Noting that the claim language underlined above with respect to claims 25 and 65 clearly show the similar claim language between the two claims, it cannot be said that combination claim 65 (ABsp) does not rely upon the specific details of subcombination claim 25 (Bsp) for patentability. If this is not so, is the position taken in the Office Actions that the recital of coupling components for supporting signal carriers the part of the claimed wavelength division device of combination claim 65 that is relied upon for patentability?

Based upon the foregoing, application of either the proper criteria for finding distinctness as recited in MPEP 806.05(c)

or the criteria stated in the June 24 Office Action shows that Group II combination claim 65 both requires and relies upon language of the recited diffraction grating (the subcombination) for patentability.

It is noted that neither Office Action entered in this case has explained or in any way supported the contention that combination claim 65 does not rely upon the particulars of the diffraction grating recited therein.

Applicants respectfully submit that with claim 25 being a Group I subcombination claim (Bsp) and claim 65 being a Group II combination claim (ABsp), Section II of MPEP 806.05(c) is applicable, instead of Section III thereof.

In the June 24 Office Action, it is stated that a further restriction requirement is necessary as between the claims in Group III (claims 2-34) and the claims in Group IV (35-39 and 46-50). Applicants elect the claims of Group IV without traverse.

In item no. 6 of the June 24 Office Action, it is stated that claim 1 is considered a linking claim. Applicants respectfully submit that claim 1 may not necessarily be a linking claim with respect to the claims of Group IV, and submit that claim 1 may be best prosecuted with the claims of Group III (an option provided in the June 24 Office Action).

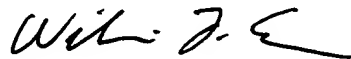
Patent Application  
Docket No. 34013-28  
D-99019

In light of Applicants election of the claims of Group IV to prosecute in the present case, and the reasons stated above for the faulty restriction between the claims of Group I and Group II, it is believed that the claims that should properly be prosecuted in this case are claims 35-39 and 46-50 (Group IV) as well as claims 101-105 and 112-116 (Group II claims directed to blazed gratings having sub-species w, see item no. 6 of the March 15 Office Action). Noting the relatively small number of claims, the similar claim language between subcombination claim 35 and combination claim 101 as well as the similar claim language between subcombination claim 46 and combination claim 112, there is believed to be no serious burden on the Examiner to examine these claims in a single application.

It is believed that this application is now in a condition for allowance, and such a Notice is requested. Favorable consideration is respectfully requested.

Respectfully submitted,

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806.04(i)

MANUAL OF PATENT EXAMINING PROCEDURE

species claimed are considered clearly unpatentable over each other.

In making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other, with the statement that restriction as between those species is not required.

Where generic claims are allowed in a national application, applicant may claim in the *same application* additional species as provided by 37 CFR 1.141.

Where, however, an applicant optionally files another national application with claims to a different species, or for a species disclosed but not claimed in a parent case as filed and first acted upon by the examiner, there should be close investigation to determine the presence or absence of patentable difference. See MPEP § 804.01 and § 804.02.

**806.04(i) Generic Claims Presented for First Time After Issue of Species**

The Office no longer follows the practice of prohibiting the allowance of generic claims that are presented for the first time after the issuance of a copending application claiming plural species. Instead, the Office may reject the generic claims on the grounds of obviousness-type double patenting. Applicant may overcome such a rejection by filing a terminal disclaimer. See *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967).

**806.05 Related Inventions**

Where two or more related inventions are being claimed, the principal question to be determined in connection with a requirement to restrict or a rejection on the ground of double patenting is whether or not the inventions as claimed are distinct. If they are distinct, restriction may be proper. If they are not distinct, restriction is never proper. If nondistinct inventions are claimed in separate applications or patents, double patenting must be held, except where the

additional applications were filed consonant with a requirement to restrict in a national application.

The various pairs of related inventions are noted in the following sections.

**806.05(a) Combination and Subcombination or Element**

A combination is an organization of which a subcombination or element is a part.

Relative to questions of restriction where a combination is alleged, the claim thereto must be assumed to be allowable (novel and unobvious) as pointed out in MPEP § 806.02, in the absence of a holding by the examiner to the contrary. When a claim is found in a patent, it has already been found by the Office to be allowable and must be treated on that basis.

**806.05(b) Old Combination — Novel Subcombination**

Restriction is ordinarily not proper between a combination (AB) that the examiner holds to be old and unpatentable and the subcombination (B) in which the examiner holds the novelty, if any, to reside. *Ex parte Donnell*, 1923 C.D. 54, 315 O.G. 398 (Comm'r Pat.1923). See MPEP § 820.01.

**806.05(c) Criteria of Distinctness for Combination, Subcombination, or Element of a Combination**

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See MPEP § 808.02.

The inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in other and different relations.

When these factors cannot be shown, such inventions are not distinct.

The following examples are included for general guidance.

## I. SUBCOMBINATION NOT ESSENTIAL TO COMBINATION

### *AB<sub>br</sub>/B<sub>sp</sub> Restriction Proper*

Where a combination as claimed does not set forth the details of the subcombination as separately claimed and the subcombination has separate utility, the inventions are distinct and restriction is proper if reasons exist for insisting upon the restriction; i.e., separate classification, status, or field of search.

This situation can be diagrammed as combination AB<sub>br</sub> ("br" is an abbreviation for "broad"), and subcombination B<sub>sp</sub> ("sp" is an abbreviation for "specific"). B<sub>br</sub> indicates that in the combination the subcombination is broadly recited and that the specific characteristics set forth in the subcombination claim B<sub>sp</sub> are not set forth in the combination claim.

Since claims to both the subcombination and combination are presented and assumed to be patentable, the omission of details of the claimed subcombination B<sub>sp</sub> in the combination claim AB<sub>br</sub> is evidence that the patentability of the combination does not rely on the details of the specific subcombination.

## II. SUBCOMBINATION ESSENTIAL TO COMBINATION

### *AB<sub>sp</sub>/B<sub>sp</sub> No Restriction*

If there is no evidence that combination AB<sub>sp</sub> is patentable without the details of B<sub>sp</sub>, restriction should not be required. Where the relationship between the claims is such that the separately claimed subcombination B<sub>sp</sub> constitutes the essential distinguishing feature of the combination AB<sub>sp</sub> as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility.

## III. SOME COMBINATION CLAIMS RECITE SPECIFIC FEATURES OF THE SUBCOMBINATION BUT OTHER COMBINATION CLAIMS GIVE EVIDENCE THAT THE SUBCOMBINATION IS NOT ESSENTIAL TO THE COMBINATION.

### *AB<sub>sp</sub>/AB<sub>br</sub> (Evidence Claim)/B<sub>sp</sub> Restriction Proper*

Claim AB<sub>br</sub> is an evidence claim which indicates that the combination does not rely upon the specific details of the subcombination for its patentability. If claim AB<sub>br</sub> is subsequently found to be unallowable, the question of rejoinder of the inventions restricted must be considered and the letter to the applicant should so state. Therefore, where the combination evidence claim AB<sub>br</sub> does not set forth the details of the subcombination B<sub>sp</sub> and the subcombination B<sub>sp</sub> has separate utility, the inventions are distinct and restriction is proper if reasons exist for insisting upon the restriction.

In applications claiming plural inventions capable of being viewed as related in two ways, for example, as both combination-subcombination and also as different statutory categories, both applicable criteria for distinctness must be demonstrated to support a restriction requirement. See also MPEP § 806.04(b).

Form paragraph 8.15 may be used in combination-subcombination restriction requirements.

### **8.15** *Combination-Subcombination*

Inventions [1] and [2] are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because [3]. The subcombination has separate utility such as [4].

#### **Examiner Note:**

1. This form paragraph is to be used when claims are presented to both combination(s) and subcombination(s) (MPEP § 806.05(c)).
2. In situations involving evidence claims, see MPEP § 806.05(c), example 3, and explain in bracket 3.
3. In bracket 4, suggest utility other than used in the combination.
4. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

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806.05(a)

MANUAL OF PATENT EXAMINING PROCEDURE

# **806.05(a) Combination and Subcombination or Element**

A combination is an organization of which a subcombination or element is a part.

Relative to questions of restriction where a combination is alleged, the claim thereto must be assumed to be allowable (novel and unobvious) as pointed out in MPEP § 806.02, in the absence of a holding by the examiner to the contrary. When a claim is found in a patent, it has already been found by the Office to be allowable and must be treated on that basis.

## **806.05(b) Old Combination — Novel Subcombination**

Restriction is ordinarily not proper between a combination (AB) that the examiner holds to be old and unpatentable and the subcombination (B) in which the examiner holds the novelty, if any, to reside. *Ex parte Donnell*, 1923 C.D. 54, 315 O.G. 398 (Comm'r Pat.1923). See MPEP § 820.01.

## **806.05(c) Criteria of Distinctness for Combination, Subcombination, or Element of a Combination**

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See MPEP § 808.02.

The inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in other and different relations.

**When these factors cannot be shown, such inventions are not distinct.**

The following examples are included for general guidance.

## **I. SUBCOMBINATION NOT ESSENTIAL TO COMBINATION**

### ***AB<sub>br</sub>/B<sub>sp</sub> Restriction Proper***

Where a combination as claimed does not set forth the details of the subcombination as separately claimed and the subcombination has separate utility, the inventions are distinct and restriction is proper if reasons exist for insisting upon the restriction; i.e., separate classification, status, or field of search.

This situation can be diagrammed as combination AB<sub>br</sub> ("br" is an abbreviation for "broad"), and subcombination B<sub>sp</sub> ("sp" is an abbreviation for "specific"). B<sub>br</sub> indicates that in the combination the subcombination is broadly recited and that the specific characteristics set forth in the subcombination claim B<sub>sp</sub> are not set forth in the combination claim.

Since claims to both the subcombination and combination are presented and assumed to be patentable, the omission of details of the claimed subcombination B<sub>sp</sub> in the combination claim AB<sub>br</sub> is evidence that the patentability of the combination does not rely on the details of the specific subcombination.

## **II. SUBCOMBINATION ESSENTIAL TO COMBINATION**

### ***AB<sub>sp</sub>/B<sub>sp</sub> No Restriction***

If there is no evidence that combination AB<sub>sp</sub> is patentable without the details of B<sub>sp</sub>, restriction should not be required. Where the relationship between the claims is such that the separately claimed subcombination B<sub>sp</sub> constitutes the essential distinguishing feature of the combination AB<sub>sp</sub> as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility.

## **III. SOME COMBINATION CLAIMS RECITE SPECIFIC FEATURES OF THE SUBCOMBINATION BUT OTHER COMBINATION CLAIMS GIVE EVIDENCE THAT THE SUBCOMBINATION IS NOT ESSENTIAL TO THE COMBINATION.**

### ***AB<sub>sp</sub>/AB<sub>br</sub> (Evidence Claim)/B<sub>sp</sub> Restriction Proper***

Claim AB<sub>br</sub> is an evidence claim which indicates that the combination does not rely upon the specific details of

the subcombination for its patentability. If claim AB<sub>br</sub> is subsequently found to be unallowable, the question of rejoinder of the inventions restricted must be considered and the letter to the applicant should so state. Therefore, where the combination evidence claim AB<sub>br</sub> does not set forth the details of the subcombination B<sub>sp</sub> and the subcombination B<sub>sp</sub> has separate utility, the inventions are distinct and restriction is proper if reasons exist for insisting upon the restriction.

In applications claiming plural inventions capable of being viewed as related in two ways, for example, as both combination—subcombination and also as different statutory categories, both applicable criteria for distinctness must be demonstrated to support a restriction requirement. See also MPEP § 806.04(b).

Form Paragraph 8.15 may be used in combination—subcombination restriction requirements.

#### **8.15 Combination—Subcombination**

Inventions [1] and [2] are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because [3]. The subcombination has separate utility such as [4].

#### **Examiner Note:**

1. This form paragraph is to be used when claims are presented to both combination(s) and subcombination(s) (MPEP § 806.05(c)).
2. In situations involving evidence claims, see MPEP § 806.05(c), example 3, and explain in bracket 3.
3. In bracket 4, suggest utility other than used in the combination.
4. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

The burden is on the examiner to suggest an example of separate utility.

If applicant proves or provides an argument supported by facts, that the other utility, suggested by the examiner, cannot be accomplished, the burden shifts to the examiner to document a viable separate utility or withdraw the requirement.

#### **806.05(d) Subcombinations Usable Together**

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other.

Care should always be exercised in this situation to determine if the several subcombinations are generically claimed. See MPEP § 806.04(b).

Form Paragraph 8.16 may be used in restriction requirements between subcombinations.

#### **¶ 8.16 Subcombinations, Usable Together**

Inventions [1] and [2] are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case invention [3] has separate utility such as [4]. See MPEP § 806.05(d).

#### **Examiner Note:**

1. This form paragraph is to be used when claims are presented to subcombinations usable together (MPEP § 806.05(d)).
2. In bracket 3, insert the appropriate group number or identify the invention.
3. In bracket 4, suggest utility other than with the other invention.
4. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

Only one—way distinctness is required.

The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination.

Care must be taken to determine if the subcombinations are generically claimed.

Where subcombinations as disclosed and claimed are both (a) species under a claimed genus and (b) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to related inventions. If restriction is improper under either practice, it should not be required (MPEP § 806.04(b)).

The burden is on the examiner to provide an example.

If applicant proves or provides an argument, supported by facts, that the other use, suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative use or withdraw the requirement.

#### **806.05(e) Process and Apparatus for Its Practice — Distinctness**

In applications claiming inventions in different statutory categories, only one—way distinctness is generally needed to support a restriction requirement. See MPEP § 806.05(c).

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (1) that the process *as claimed* can be practiced by another materially different apparatus or by hand, or (2) that the apparatus *as claimed* can be used to practice another and materially different process.